

REMARKS/ARGUMENTS

Information Disclosure Statement

The Office Action states the Information Disclosure Statement filed on 08/29/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each non-patent literature publication or portion which caused it to be listed. Applicant submitted a copy of "Leica Microscopy Systems Ltd. - Brochure - '0° assistant's microscope, stereo', Published June, 1998" to the USPTO on 08/29/2005, but it appears the copy was not processed by the USPTO. Applicant has filed an additional Information Disclosure Statement on the same date as this response to make this reference of record.

Claim Objections

Claims 15-17 are objected to because claims 15-17 recite dependence from cancelled claim 1. Claims 15-17 have been amended to properly recite dependence from claim 14 as suggested by the Examiner. Withdrawal of the objection to claims 15-17 is courteously requested.

Claim Rejections - 35 USC § 102

Claims 14-16, 19, 20, 22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent App. Pub. No. 2004/0105147 (Hermann et al.). Applicant respectfully traverses the rejection as to claims 14-16, 19, 20, 22 and 24 and courteously requests reconsideration as explained below.

Applicant relies on his foreign priority date to overcome the Hermann et al. reference. The earliest possible prior art date under 35 U.S.C. 102(e) afforded to this reference is the U.S. filing date of September 22, 2003. See Example 3 of MPEP 706.02(f)(1); MPEP 2136.03. The present application claims priority of German Pat. App. No. 102 55 967.8, which was filed November 29, 2002.

In accordance with 35 U.S.C. 119(b)(3) and 37 C.F.R. 1.55(a)(3), applicant hereby perfects his claim of priority to German Pat. App. No. 105 55 967.8 by submitting herewith an accurate English translation of the Certified Copy of German Patent Application No. 102 55 967.8 currently on file with the USPTO in the present application, accompanied by a Translator's

Statement attesting to the accuracy of the translation. Thus, Hermann et al. may not be relied upon as a prior art reference against the present application.

Removal of the rejection under 35 USC § 102 is respectfully requested.

Claim Rejections - 35 USC § 103

Claims 14-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent App. Pub. No. 2001/0010592 (Nakamura) in view of U.S. Patent No. 5,898,518 (Biber). Applicant respectfully traverses the rejection and courteously requests reconsideration for the following reasons.

On page 5 of the Office Action, the Examiner states the Nakamura reference fails to describe the beam splitter arranged between the main objective and the zoom and Applicant agrees. The Examiner relies on Biber in determining it would have been obvious to a person of ordinary skill in the art to arrange the beam splitter of Nakamura between the main objective and zoom system for (i) the advantages taught in col. 1, lines 51-65 of Biber reference or (ii) to reduce the number of parts (multiple objectives) as would be understood by one of ordinary skill. Applicant respectfully disagrees.

Col. 1, lines 51-65 of the Biber reference describes an arrangement to allow either a main observer or a co-observer to optimize illumination characteristics by providing an illuminating unit that rotates relative to the main observer and the co-observer, so that either the main observer or the co-observer may control the illuminating unit without having to change their viewing positions. In Nakamura, the illumination system 13 is housed in main microscope body 2 and receives light from optical fiber 14. Therefore, repositioning beam splitter B1 of Nakamura to a location between objective 21 and zoom 22 would do nothing at all for achieving the purported advantage described at Col. 1, lines 51-65. The motivating advantage stated in the Office Action would not be furthered by the suggested modification.

As to reducing parts, Nakamura specifically and repeatedly teaches away from having a shared objective for the main observer and co-observer. Nakamura teaches that it is desirable to have a separate objectives for the main observer and co-observer to enable independent magnification adjustment so that different surgical procedures may be performed simultaneously by the main observer and the co-observer. See Nakamura at paragraphs [0015], [0029] and

[0046]. Therefore, the prior art itself, which one skilled in the art at the time of the invention would refer to for teaching, states that it is an advantage, not a disadvantage, to have independent objectives.

Another aspect of Nakamura runs counter to modifying the location of beam splitter B1 as suggested in the Office Action. In particular, Nakamura is built for easy detachment of the assistant's microscope 7, whereby a main observer is given a wide view with the naked eye around the target (object). Paragraph [0046] states:

The assistant microscope of any one of the first and second embodiments is easy to detach when not needed, and the stereomicroscope without the assistant microscope is operable by itself to observe a target. If the assistant microscope is removed, an observer on the stereomicroscope may secure a wide view around the stereomicroscope when seeing a target with the naked eye.

This aspect is also mentioned at paragraph [0030] of Nakamura. If one were to relocate beam splitter B1 as suggested in the Office Action, easy removal of the assistant's microscope would become a much more challenging design feature because the assistant's microscope 7 would no longer be at the bottom of the main microscope body 2 (note that Biber does not even describe removal of co-observer microscope 37), and a net gain in space between the object and the main microscope body upon removal of the assistant's microscope would be forfeited.

In light of the above comments, applicant respectfully contends that the combined teachings of Nakamura and Biber would not have rendered claim 14 obvious at the time the invention was made.

The prior art references when combined must teach or suggest all the claim limitations. MPEP 706.02(j). Here, the references fail to teach or suggest the beam splitter arranged between the main objective and the zoom. It is improper to combine references where the references teach away from their combination, and the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP 2145. In this respect, by following the suggestions on page 5 of the Office Action, the assistant's microscope of Nakamura would not be easily detachable, nor would it have an independent objective system, both important features of the primary reference.

For the above reasons, claim 14, and its dependent claims 15-29, are thought to be allowable over the Nakamura in view of Biber.

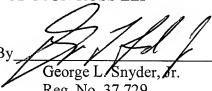
With specific regard to claim 28, which has been amended, it is noted that Biber discloses a one part objective through which illumination and observation beams pass, and Nakamura discloses a two part objective system wherein each part is for a respective observation beam path (main and assistant); the illumination beam reflected at M1 does not pass through either objective part in Nakamura. It is also pointed out that a motivation given in the Office Action for combining Biber with Nakamura is to reduce parts by having a single objective, and yet the rejection of claim 28 relies on Nakamura's disclosure of a two-part objective.

For the reasons above, favorable reconsideration of claims 14-29 is respectfully requested.

Conclusion

The present application is thought to be in a condition for allowance. If the Examiner has any questions, or the attorneys for applicant can assist in any way, the undersigned attorney may be contacted at the number provided below. The Examiner is authorized to charge any additional fees to deposit account number 08-2442.

Respectfully submitted,
HODGSON RUSS LLP

By 
George L. Snyder, Jr.
Reg. No. 37,729

GLS/

The Guaranty Building
140 Pearl Street, Suite 100
Buffalo, New York 14202-4040
(716) 856-4000
DATED: August 11, 2007